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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	86004595
Applicant	LumaSense Technologies Holdings, Inc.
Applied for Mark	SMARTDGA
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Serial No. **86004595**

Mark: **SmartDGA and design**

Applicant: **LumaSense Technologies Holdings, Inc.**

Examining Attorney: **Jennifer D. Richardson**
 Law Office 113

EX PARTE APPEAL

APPLICANT'S BRIEF

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DESCRIPTION OF RECORD

A. PROSECUTION HISTORY

The SmartDGA (and design) mark was initially refused on October 25, 2013, in a Non-Final Office Action. Applicant filed a Response to the Office Action on April 25, 2014. A Final Refusal of Registration for the mark SmartDGA (and design) was issued by the Examining Attorney on May 16, 2014, based on the Examining Attorney's conclusion that the proposed mark is merely descriptive under Trademark Act Section 2(e)(1), 15 U.S.C. § 1052(e) (1). Applicant's Request for Reconsideration and Notice of Appeal were timely filed on November 14, 2014. The Examining Attorney refused the Request for Reconsideration under 2(e)(1) on December 5, 2014.

B. EXAMINING ATTORNEY'S EVIDENCE

October 25, 2013, Office Action

The Examining Attorney offered sixteen pages of evidence, ostensibly showing that the SmartDGA (and design) mark is descriptive, including Applicant's prior Supplemental Registration, No. 4416158 for the word mark "SmartDGA" as evidence of Applicant's admission of descriptiveness. Also included are copies of pages from online dictionaries showing the definition of the word "smart." A copy of a Wikipedia page showing the meaning of the term "Dissolved gas analysis," as well as copies of webs pages from Siemens and www.electrical4u.com to show that the term "DGA" is substantially synonymous with the wording "dissolved gas analysis."

May 16, 2014, Final Office Action

The Examining Attorney offered three additional pages of evidence in support of her allegation that the design of the mark is not sufficiently distinct as to overcome the descriptiveness refusal, and specifically, that consumers will view the design of the mark as little more than a background design. Among her evidence is a screenshot from the Honeymaid website, a screenshot from the Rowse Honey website (a UK company), and a screenshot from the Hampton Inn website, all purporting to show shapes that are considered mere background designs. However, in all three of these examples, the shape pointed out by the Examiner is part of a registered trademark, two of which are registered in the U.S. Trademark Office.

C. APPLICANT'S EVIDENCE

April 25, 2014, Response to Office Action

Applicant submitted a disclaimer of the wording “SmartDGA,” along with arguments against a descriptiveness refusal.

Request for Reconsideration after Final Action

Applicant submitted evidence of similar registered trademarks that demonstrate the uniqueness of the SmartDGA (and design mark), and presented arguments that the SmartDGA (and design) mark in its entirety is capable of distinguishing Applicant's goods from those of others. The design portions of the mark in combination are inherently distinctive to qualify for allowance.

ARGUMENT

A. LEGAL STANDARD

The Trademark Examining Attorney refused registration under Section 2(e)(1) of the Trademark Act on the grounds that the term “SmartDGA” is merely descriptive, as applied, to the goods provided under the mark, and that the stylized lettering and background design are not inherently distinctive, and fail to function as a source indicator.

Applicant has disclaimed the term “SmartDGA” and, as such, the disclaimed word is not merely descriptive as applied to applicant’s goods. The Examiner’s asserted evidence of descriptiveness of the word portion by itself is not sufficient to address the design features of Applicant’s trademark. Neither the stylized lettering nor the background design can be considered merely descriptive as applied to applicant’s goods, therefore Section 2(e) is not applicable as a grounds for rejection. *In re Wella Corp.*, 635 F.2d 845, 196 USPQ 7 (CCPA 1977). While an entire mark cannot be disclaimed and also registered, nevertheless where any unregistrable components of a mark are presented in a distinctive display, it is possible to disclaim the unregistrable components and still have a mark which is registrable as a whole. *In re Miller Brewing Company*, 226 U.S.P.Q. 666 at 667. Therefore, the question at hand is whether the particular SmartDGA (and design) mark is capable of distinguishing Applicant’s goods, and thereby functioning as a trademark as defined in Section 45, and within the meaning of the preamble of Section 2 of the Trademark Act. The Trademark Act states that unless one or more of subsections (a)-(f) apply, “no trademark by which the goods of the applicant may be distinguished from the goods of others shall be refused registration on the principal register on account of its nature.” Case law holds that a distinctive display of disclaimed unregistrable components is registerable upon the Principal Register in those cases where the features of the

display are of such nature that they would inherently serve to distinguish the mark in its entirety, or where it has been shown through competent evidence that what is sought to be registered does in fact function as a trademark to identify and distinguish applicant's goods in commerce. *In re Miller Brewing Company*, 226 U.S.P.Q. 666 at 668. Applicant posits that the SmartDGA (and design) mark is sufficiently inherently distinctive as to warrant registration on the Principal Register, and further currently functions as a sole source indicator for the associated goods in Class 009.

B. ANALYSIS

1. MARK IS SUFFICIENTLY INHERENTLY DISTINCTIVE

The design features of Applicant's mark create an impression on relevant purchasers that is separate and apart from the impression made by the words. The entire mark must be considered. It is not proper to separate parts and disregard a distinctive design feature uniquely combined with a stylized word portion. *In re Miller Brewing Co.*, 226 USPQ 666 (TTAB 1985). When observable characteristics of a mark show that the mark has a distinct meaning of its own, independent of its constituent elements, it is a unitary mark. *Dena Corp. v. Belvedere Intern., Inc.*, 950 F.2d 1555, 1561 (Fed. Cir. 1991). In this application, it is deemed improper to separate the word elements from the background elements and to consider them separately. For example, the Final Office Action states "the shaded elongated hexagon represents a common background shape that consumers are accustomed to viewing as merely a background element in a mark, and not as a source indicator," thereby evidencing the consideration of the mark in separate parts instead of the mark as a whole. Case law requires the mark to be considered as a whole. Moreover, there is no support for the assertion that relevant consumers of Applicant's products

are “accustomed to viewing” such a background. No similar backgrounds are shown for goods or services in this field or in any related fields. It is respectfully submitted that no truly similar background has been shown in any evidence in this case. When considered as a whole, the mark has many elements that together create a distinct commercial impression. The mark consists of the words “SmartDGA” in a particularly stylized font (compared to any similar marks cited by the Examiner), on top of a distinctly-shaped hexagon. The hexagon is uniquely colored with shades of gold and is particularly shaded to represent a three dimensional shape appearing to project a pyramid from the page. Further, the hexagon is not descriptive of the goods or features therefor. The entire combination of the stylized words and unique colored background creates a distinct commercial impression.

In the present application, the design features are at least as distinctive apart from the words as in other cases where the TTAB has found distinctiveness upon the design features. For example, despite the descriptive wording in “CONSTRUCT-A-CLOSET,” for components that are to be used in the construction of closets, the mark was allowed registration on the principal register, with a disclaimer, because of the sufficiently inherent distinctive design, despite being a simple white background with black lines extended horizontally from the ends of the “C” in “Construct” and from the ends of the “C” in “Closet.” *Attached as Exhibit A. See In re Clutter Control Inc.*, 231 USPQ 588 (TTAB 1986). In addition, the descriptive mark “KAR AUCTION SERVICES,” despite being initially refused for descriptiveness, was allowed principal registration, with a disclaimer, by the Trademark Trial and Appeal Board because they found it to be sufficiently stylized to create an inherently distinctive display. The word “KAR” was in a different size font from “Auction Services” and there was a space between the letters “K” and “R,” giving an impression of a logo. *Attached as Exhibit B. See In re Kar Auction Services*,

Inc., 2011 TTAB LEXIS 389. Again, as in the *Clutter Control* case, the “KAR AUCTION SERVICES” mark was a simple design with no color features. Applicant’s mark, in contrast, includes both stylization of the words, a uniquely shaped three-dimensional polygon, having a unique coloration (claimed as part of the mark), where the color variations create a unique image of depth to give the impression of three dimensions. The entire combination clearly gives an impression of a logo. *Id.*

In the instant case, Applicant does not claim acquired distinctiveness. Instead, Applicant contends that the applied-for mark, in its entire combination, is sufficiently inherently distinct as to permit registration on the Principal Register. It is simply not proper to assert, as the Examining Attorney did in the initial Office Action, that Applicant’s mark consists of “a gold polygon shape” and that this design element is not sufficiently distinct as to overcome the descriptiveness refusal. The entire design mark, as shown in the drawing, must be considered, not only a summary phrase describing part of the design in its simplest terms. First, it should be recognized based upon the cited cases, that even a simple polygon is sufficiently distinctive for registration purposes when combined with stylized letters. Moreover, Applicant respectfully disagrees with the assertion that Applicant’s mark is simply a “gold polygon shape.” Applicant points to the Honey Maid trademark (*registration certificate attached as Exhibit C*), submitted by the Examining Attorney in the Final Office Action as a better example of a simple “gold polygon shape,” and further points out that the Honey Maid mark is registered in the U.S. Trademark Office. The polygon shape of the Applicant’s trademark is uniquely elongated horizontally, it is not merely an equilateral polygon. In fact, as indicated in the drawing and the proposed description of the mark that is considered more specific than the description proposed by the examiner, the polygon is shaded a darker gold on both the top and bottom and lighter gold

in the middle. The unique shading gives the impression that the shape is three-dimensional and gives the commercial impression of three-dimensional depth to the polygon. Down the horizontal middle of the horizontally elongated polygon is a stripe of a lighter shade of gold color, which gives the effect of light hitting the highest element of a three dimensional image. In this application, unlike other applications that might be considered, the color is specifically claimed as a feature of the mark. There is no showing of another mark claiming the same color in the identified field of goods. The shape, color and shading elements give a separate commercial impression from the letters alone and make the “SmartDGA” (and design) mark significantly more distinct than the minimally stylized, black and white marks in *Clutter Control* or *Kar Auction Services*, and numerous other registered marks on the Principal Register. Further, the word “SmartDGA” is presented in a stylized format, with the formative “Smart” appearing in both upper and lower case letters and the initials “DGA” appearing in all capital letters. The “SmartDGA” (and design) mark is claimed as stylized, and the design features in the combination are most certainly capable of catching the consumer’s attention, creating an overall commercial impression in a consumer’s mind, separate and apart from the words themselves. That is all that is required under the Trademark Act for registration. As the Trademark Act §2 states, “no trademark by which the goods of the applicant may be distinguished from the goods of others shall be refused registration on the principal register on account of its nature...,” unless it has other defects, none of which apply in this case.

Again, a fair reading of the Office Action indicates that no consideration was given to the distinct color of Applicant’s mark, aside from requesting an amendment to the color claim in the first Office Action. Applicant specifically claims the colors gold and black, shows the exact colors in the drawing, and describes the mark as “a polygon shaded in gold containing the

wording ‘SmartDGA’ in stylized black font.” Simple observation of the applied-for mark shows that the mark is not merely a “gold polygon shape” or a “shaded elongated hexagon.” It includes in combination a distinct gold color, shaded to create the effect of three dimensions with stylized lettering incorporated into the design. Indeed, the Principle Register is full of examples of far less distinctive polygons than Applicant’s. For comparison, Applicant points to Registration No. 1914973, a simple red polygon with the word “RUBBERMAID” for outdoor furniture (known to be made of a polymer material), and Registration No. 4236137, a red rectangle with the word “NETFLIX” for online (“net”) movie (“flix”) rental services. Neither the “RUBBERMAID” nor the “NETFLIX” mark contains a design as complex as Applicant’s, despite the descriptive, or at the very least highly suggestive, nature of the word portion of those other registered marks. The color gold has no relationship to Applicant’s identified goods. For the foregoing reasons, Applicant respectfully argues that the distinct color of the mark weighs heavily in favor of registration on the Principal Register.

The Final Rejection cites the same two cases as the first Office Action, standing for the principle that merely descriptive marks are not registerable. However, neither case is applicable to the facts at hand. In the first case, *In re Bonni Keller Collections, Ltd.*, the applied-for mark consists merely of the words “LA LINGERIE,” for undergarments and retail store services, in stylized font with no distinctive background, no color and minimally-stylized lettering. 6 U.S.P.Q. 2d 1224 (TTAB 1987). The second case, *In re Sambado & Sons, Inc.*, the applied-for mark again consisted merely of the words “FRUTTA FRESCA” for fresh deciduous fruits, in minimally-stylized font, without a distinctive background and without color. 45 U.S.P.Q. 2d 1312 (TTAB 1997). For the reasons stated above, the cases cited in the Office Actions are clearly distinguishable from the case at hand.

Lastly, in the Final Rejection, the Examining Attorney attaches three examples purporting to show hexagons used as non-distinct background shapes in furtherance of her argument that the SmartDGA (and design) mark lacks the required distinctiveness for Principal Registration. The Examining Attorney's examples were the design marks from the Honeymaid website, the Hampton Inn website, and the Rowse Honey website (a UK company). However, in all three of these examples, the shape pointed out by the Examiner is part of a registered trademark, the first of which registered in the U.S. Trademark Office, the second of which is a variant of a registered U.S. trademark, and the last is registered in the United Kingdom. *See Exhibit C, Exhibit D.*

Therefore, Applicant respectfully submits, as others have successfully done in other cases approved for registration, that the "stylization of the words [and] the accompanying design features of the asserted mark create an impression on purchasers separate and apart from the impression made by the words themselves." *In re American Academy of Facial Plastic and Reconstructive Surgery*, 64 USPQ2d 1748, 1753 (TTAB 2002). On that basis, Applicant respectfully requests registration on the Principal Register.

CONCLUSION

Applicant respectfully submits that the SmartDGA (and design) mark is sufficiently distinct to warrant registration on the Principal Register. Applicant again points to the other cited registrations for marks with less detail than Applicant's. With "SmartDGA" disclaimed, no part of Applicant's mark is descriptive of the associated goods. SmartDGA (and design) is capable of serving as a sole source indicator for Applicant's goods in Class 009, and in fact does currently serve as a sole source indicator for Applicant's goods in Class 009. For the foregoing reasons, SmartDGA (and design) should be allowed registration on the Principle Register.

Exhibit A

CONSTRUCT-A-CLOSET

Exhibit B

KAR
AUCTION
SERVICESSM

Exhibit C

United States of America

United States Patent and Trademark Office



Reg. No. 4,433,312

Registered Nov. 12, 2013

Int. Cl.: 30

TRADEMARK

PRINCIPAL REGISTER

INTERCONTINENTAL GREAT BRANDS LLC (DELAWARE LIMITED LIABILITY COMPANY)
100 DEFOREST AVENUE
EAST HANOVER, NJ 07936

FOR: COOKIES; CRACKERS, IN CLASS 30 (U.S. CL. 46).

FIRST USE 6-30-2012; IN COMMERCE 6-30-2012.

OWNER OF U.S. REG. NOS. 4,794,394, 3,902,898, AND 3,154,165.

THE COLOR(S) YELLOW, BLUE, AND WHITE IS/ARE CLAIMED AS A FEATURE OF THE MARK.

THE MARK CONSISTS OF A YELLOW 6-SIDED SHAPE. WITHIN THE SHAPE ARE THE WORDS "HONEY MAID" WRITTEN IN BLUE WITH "HONEY" ABOVE THE WORD "MAID". ABOVE THE "N" IN "HONEY" IS A FANCY BEE WHICH HAS A BLUE AND YELLOW STRIPED BODY, A YELLOW HEAD AND BLUE EYES, WINGS AND ANTENNAE. A GENERALLY OVAL SHAPED WHITE BACKGROUND APPEARS BEHIND THE BEE.

SN 85-593,690, FILED 4-10-2012

MARTHA FROMM, EXAMINING ATTORNEY



Martha Fromm
Martha Fromm, Examining Attorney, Trademark Office

Exhibit D

Int. Cl.: 42

Prior U.S. Cl.: 100

United States Patent and Trademark Office

Reg. No. 1,343,583

Registered June 18, 1985

SERVICE MARK
PRINCIPAL REGISTER



HOLIDAY INNS, INC. (TENNESSEE CORPORATION)
3742 LAMAR AVENUE
MEMPHIS, TN 38195

FIRST USE 8-1-1984; IN COMMERCE
8-1-1984.

NO CLAIM IS MADE TO THE EXCLUSIVE
RIGHT TO USE "INN", APART FROM THE
MARK AS SHOWN.

FOR: HOTEL SERVICES NAMELY, PROVID-
ING LODGING IN THE HOTELS, IN CLASS 42
(U.S. Cl. 100).

SER. NO. 506,370, FILED 10-31-1984.

CRAIG D. TAYLOR, EXAMINING ATTORNEY